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09/781,453	02/13/2001	Norihiko Nakagawa	1155-0215P	1019
2292 7590 11/24/2003 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER SROSHO, CALLIE E	
			ART UNIT 1714	PAPER NUMBER

DATE MAILED: 11/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

### Office Action Summary

Application No.

09/781,453

Applicant(s)

NAKAGAWA ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s): \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**Continued Examination Under 37 CFR 1.114**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/20/03 has been entered.

2. All outstanding rejections except for those described below are overcome by applicants' amendment and arguments filed 8/20/03.

**Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
5. Claims 1, 3-5, 7-9, 11-12, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 716121 in view of Sadatoshi et al. (U.S. 5,340,878) and JP 54120656.

EP 716121 discloses a composition comprising 5-95% propylene/1-butene random copolymer which is characterized in that the copolymer contains (i) 50-95 mol% propylene and 5-50 mol% 1-butene, (ii) molecular weight distribution  $M_w/M_n$  of not more than 3, (iii) B value of 1-1.5, (iv) melting point of 60-140 °C wherein the melting point satisfies the relationship  $-2.6M + 130 < T_m < -2.3M + 155$  where M is the mol% of 1-butene present in the copolymer, and (v) degree of crystallinity measured by x-ray diffractometry of satisfying the relationship  $C > -1.5M + 75$  where M is the mol% of 1-butene present in the copolymer. The propylene/1-butene copolymer is obtained by copolymerizing propylene and 1-butene in the presence of olefin polymerization catalyst wherein the catalyst comprises transition metal compound identical to that presently claimed and an organoaluminum oxy compound and/or a compound

capable of reacting with transition metal compound to form an ion pair. The composition also comprises additives such as inorganic filler, antioxidant, antistatic agent, lubricant, UV absorber, etc. EP 716121 discloses extrusion coating comprising the above described composition. There is also disclosed a composite film comprising a substrate layer and laminated onto one side a resin layer obtained from the above composition wherein the resin layer has thickness of 0.1-50  $\mu\text{m}$  (page 2, lines 28-31 and 33-36, page 2, line 40-page 3, line 35, page 3, lines 42 and 45-46, page 4, lines 46-47 and 54-58, page 5, lines 1-32, page 9, line 7-page 10, line 58, page 18, lines 16-17 and 26-29, page 21, line 37, page 22, lines 19-25, page 24, lines 20-22, page 25, lines 1-18, and page 31, lines 23-35).

The difference between EP 716121 and the present claimed invention is the requirement in the claims of (a) melt flow rate of propylene/1-butene copolymer and (b) low-density polyethylene.

With respect to difference (a), EP 716121 is silent with respect to the melt flow rate of the propylene/1-butene copolymer.

Sadatoshi et al., which is drawn to composition comprising propylene/1-butene copolymer and ethylene/ $\alpha$ -olefin copolymer, disclose the use of propylene/1-butene copolymer having melt flow rate of 3-50 g/10min in order to produce a copolymer which has suitable transparency and workability wherein the melt flow rate is measured according to JIS K7210 (col.2, lines 41-44, 51-53, and 55-56 and col.4, lines 45-48). It is noted, as found in state-of-the-art references such as Nohara et al. (U.S. 5,891,946), that JIS K7210 standard is equivalent to ASTM D 1238 standard as presently claimed (col. 12, lines 28-31).

With respect to difference (b), EP 716121 discloses the use of polyethylene, however, there is no explicit disclosure of low-density polyethylene as presently claimed.

JP 54120656, an English translation of which is included in this office action, which is drawn to composition comprising propylene/1-butene, disclose the use of low density polyethylene which has melt flow rate of 1-40 g/10 min (measured in accordance with ASTM D-1238) and density of less than 0.94 g/cm<sup>3</sup> or preferably 0.915-0.93 g/cm<sup>3</sup>, in order to produce composition with excellent heat, wear, and scratch resistance as well as good workability time of lamination (paragraph bridging pages 4-5 and page 5, second full paragraph).

Although there is no disclosure that the film produced by the above composition possesses gloss as presently claimed, given that EP 716121 in combination with Sadatoshi et al. and JP 54120656 discloses composition identical to that presently claimed, it would have been obvious to one of ordinary skill in the art that the film produced by such composition would intrinsically possess gloss identical to that presently claimed.

In light of the motivation for using propylene/1-butene copolymer with specific melt flow rate disclosed by Sadatoshi et al. and the motivation for using low-density polyethylene disclosed by JP 54120656 as described above, it therefore would have been obvious to one of ordinary skill in the art to use such propylene/1-butene and low-density polyethylene in the composition of EP 716121 in order to produce a composition with good transparency and workability, as well as good moldability and impact strength or alternatively, excellent heat, wear, and scratch resistance and thereby arrive at the claimed invention.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 716121 in view of Sadatoshi et al. and JP 54120656 as applied to claims 1, 3-5, 7-9, 11-12, and 14-15 above, and further in view of Yoshimura et al. (U.S. 5,443,765).

The difference between EP 716121 in view of Sadatoshi et al. and JP 54120656 and the present claimed invention is the requirement in the claims of specific type low-density polyethylene.

Yoshimura et al., which is drawn to composite film, disclose the use of low-density ethylene/C<sub>3</sub>-C<sub>12</sub>  $\alpha$ -olefin copolymer which has melt flow rate of 0.2-15 g/10 min measured using ASTM D 1238 conditions and density of 0.89-0.935 g/cm<sup>3</sup>. The motivation for using such polyethylene is due to its excellent stretchability, softness, and strength (col.11, lines 20-21, 25, and 57, col.12, lines 3-16, and col.32, line 22).

In light of the motivation for using specific high-pressure low-density polyethylene disclosed by Yoshimura et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such polyethylene in the composition of EP 716121 in order to produce a composition with excellent stretchability, softness, and strength, and thereby arrive at the claimed invention.

7. Claims 1, 3, 5, and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugano et al. (U.S. 5,468,781) in view of EP 716121 and JP 54120656.

Sugano et al. disclose composition comprising 100 parts propylene/1-butene random copolymer which comprises 0.1-25% 1-butene and possesses melt flow rate measured using ATSM D 1238 at 230 °C and 2.16 kg of 0.1-50 g/10 min, 1-50 parts high-pressure low-density

polyethylene, and less than 5 parts additives such as antioxidant, antistatic agent, and UV absorber. Based on the above amounts, it is calculated that the composition comprises approximately 67-99% (100/150-100/101) propylene/1-butene and 0.99-33% (1/101-50/150) high-pressure low-density polyethylene. The propylene/1-butene copolymer is obtained by copolymerizing propylene and 1-butene in the presence of olefin polymerization catalyst comprising transition metal compound identical to that presently claimed such as dimethyl silylene bis(2-methyl-4-phenylindenyl) zirconium chloride and compound such as alumoxane or Lewis acid which is capable of reacting with the transition metal compound to form an ion pair (col.2, line 50-col.3, line 28, col.3, lines 48-49, col.5, lines 4-10 and 24-28, col.5, line 66-col.6, line 3, and col.6, lines 13 and 21-23).

The difference between Sugano et al. and present claimed invention is the requirement in the claims of (a) molecular weight distribution, B value, melting point, and crystallinity of propylene/1-butene copolymer, (b) density and melt flow rate of low-density polyethylene, and (c) filler.

With respect to difference (a), EP 716121, which is drawn to polypropylene composition, disclose the use of propylene/1-butene random copolymer characterized in that the copolymer has (i) molecular weight distribution  $M_w/M_n$  of not more than 3, (ii) B value of 1-1.5, (iii) melting point of 60-140 °C wherein the melting point satisfies the relationship  $-2.6M + 130 < T_m < -2.3M + 155$  where M is the mol% of 1-butene present in the copolymer, and (iv) degree of crystallinity measured by x-ray diffractometry of satisfying the relationship  $C > -1.5M + 75$  where M is the mol% of 1-butene present in the copolymer. The motivation for using such copolymer is to produce a composition excellent in heat resistance and low temperature sealing

properties as well as flexibility and impact resistance (col.2, lines 4-7, col.4, lines 54-58, and col.5, lines 1-5 and 18-31).

With respect to difference (b), JP 54120656, which is drawn to composition comprising propylene/1-butene, disclose the use of low density polyethylene which has melt flow rate of 1-40 g/10 min (measured in accordance with ASTM D-1238) and density of less than  $0.94 \text{ g/cm}^3$  or preferably  $0.915\text{-}0.93 \text{ g/cm}^3$ , in order to produce composition with excellent heat, wear, and scratch resistance (paragraph bridging pages 4-5 and page 5, second full paragraph).

Although there is no disclosure that a film produced by the above composition would possess gloss as presently claimed, given that Sugano et al. in combination with EP 716121 and JP 54120656 discloses composition identical to that presently claimed, it would have been obvious to one of ordinary skill in the art that a film produced by such composition would intrinsically possess gloss identical to that presently claimed. It is noted that there is no disclosure in Sugano et al. of film produced by the disclosed composition. However, present claim 1 is drawn to a composition not a film. There is no requirement in present claim 1 that a film with the claimed gloss is actually formed, only that a film obtained by the composition would possess such gloss.

In light of the motivation for using specific propylene/1-butene copolymer and high-pressure low-density polyethylene disclosed by EP 716121 and JP 54120656, respectively, it therefore would have been obvious to one of ordinary skill in the art to use such specific propylene/1-butene copolymer and low-density polyethylene in the composition of Sugano et al. in order to produce a composition with excellent in heat resistance, low temperature sealing properties, flexibility and impact resistance as well as good impact strength, spiral flow,

transparency, and anti-blocking resistance or alternatively, excellent heat, wear, and scratch resistance, and thereby arrive at the claimed invention.

With respect to difference (c), EP 716121 discloses the use of inorganic filler in order to produce a composition that is excellent in weld strength, paintability, and molding processability (col.21, line 37-col.22, line 4).

In light of the motivation for using inorganic filler disclosed by EP 713121 as described above, it therefore would have been obvious to one of ordinary skill in the art to use such filler in the composition of Sugano et al. in order to produce a composition with excellent weld strength, paintability, and molding processability, and thereby arrive at the claimed invention.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sugano et al. in view of EP 716121 and JP 54120656 as applied to claims 1, 3, 5, and 7-8 above, and further in view of Yoshimura et al. (U.S. 5,443,765).

The difference between Sugano et al. in view of EP 716121 and JP 54120656 and the present claimed invention is the requirement in the claims of specific type of low-density polyethylene.

Yoshimura et al., which is drawn to composite film, disclose the use of high-pressure low-density ethylene/C<sub>3</sub>-C<sub>12</sub> α-olefin copolymer which has melt flow rate of 0.2-15 g/10 min measured using ASTM D 1238 conditions and density of 0.89-0.935 g/cm<sup>3</sup>. The motivation for using such polyethylene is due to its excellent stretchability, softness, and strength (col.11, lines 20-21, 25, and 57, col.12, lines 3-16, and col.32, line 22).

In light of the motivation for using specific low-density polyethylene disclosed by Yoshimura et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such polyethylene in the composition of Sugano et al. in order to produce a composition with excellent stretchability, softness, and strength, and thereby arrive at the claimed invention.

9. Claims 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 716121 in view of Sadatoshi et al. (U.S. 5,340,878) and either JP 54120656 or Yoshimura et al. (U.S. 5,433,765).

EP 716121 discloses a composition comprising 5-95% propylene/1-butene random copolymer which is characterized in that the copolymer contains (i) 50-95 mol% propylene and 5-50 mol% 1-butene, (ii) molecular weight distribution  $M_w/M_n$  of not more than 3, (iii) B value of 1-1.5, (iv) melting point of 60-140 °C wherein the melting point satisfies the relationship  $-2.6M + 130 < T_m < -2.3M + 155$  where M is the mol% of 1-butene present in the copolymer, and (v) degree of crystallinity measured by x-ray diffractometry of satisfying the relationship  $C > -1.5M + 75$  where M is the mol% of 1-butene present in the copolymer. The propylene/1-butene copolymer is obtained by copolymerizing propylene and 1-butene in the presence of olefin polymerization catalyst wherein the catalyst comprises transition metal compound identical to that presently claimed and an organoaluminum oxy compound and/or a compound capable of reacting with transition metal compound to form an ion pair. The composition also comprises additives such as inorganic filler, antioxidant, antistatic agent, lubricant, UV absorber, etc. There is also disclosed a composite film comprising a substrate layer and laminated onto one

side a resin layer obtained from the above composition wherein the resin layer has thickness of 0.1-50  $\mu\text{m}$ . Further, EP 716121 discloses extrusion coating comprising the above described composition (page 2, lines 28-31 and 33-36, page 2, line 40-page 3, line 35, page 3, lines 42 and 45-46, page 4, lines 46-47 and 54-58, page 5, lines 1-32, page 9, line 7-page 10, line 58, page 18, lines 16-17 and 26-29, page 21, line 37, page 22, lines 19-25, page 24, lines 20-22, page 25, lines 1-18 and page 31, lines 23-35).

The difference between EP 716121 and the present claimed invention is the requirement in the claims of (a) melt flow rate of propylene/1-butene copolymer and (b) low-density polyethylene.

With respect to difference (a), EP 716121 is silent with respect to the melt flow rate of the propylene/1-butene copolymer.

Sadatoshi et al., which is drawn to composition comprising propylene/1-butene copolymer and ethylene/ $\alpha$ -olefin copolymer, disclose the use of propylene/1-butene copolymer having melt flow rate of 3-50 g/10min in order to produce a copolymer which has suitable transparency and workability wherein the melt flow rate is measured according to JIS K7210 (col.2, lines 41-44, 51-53, and 55-56 and col.4, lines 45-48). It is noted, as found in state-of-the-art references such as Nohara et al. (U.S. 5,891,946), that JIS K7210 standard is equivalent to EP 716121 discloses the use of polyethylene, however, there is no explicit disclosure of low-density polyethylene as presently claimed.

With respect to difference (b), JP 54120656, which is drawn to composition comprising propylene/1-butene, disclose the use of low density polyethylene which has melt flow rate of 1-

40 g/10 min (measured in accordance with ASTM D-1238) and density of less than 0.94 g/cm<sup>3</sup> or preferably 0.915-0.93 g/cm<sup>3</sup>, in order to produce composition with excellent heat, wear, and scratch resistance as well as good workability time of lamination (paragraph bridging pages 4-5 and page 5, second full paragraph).

Alternatively, Yoshimura et al., which is drawn to composite film, disclose the use of low-density ethylene/C<sub>3</sub>-C<sub>12</sub>  $\alpha$ -olefin copolymer which has melt flow rate of 0.2-15 g/10 min measured using ASTM D 1238 conditions and density of 0.89-0.935 g/cm<sup>3</sup>. The motivation for using such polyethylene is due to its excellent stretchability, softness, and strength (col.11, lines 20-21, 25, and 57 and col.12, lines 3-16).

Although there is no disclosure that the film produced by the above composition possesses gloss as presently claimed, given that EP 716121 in combination with Sadatoshi et al. and JP 54120656 or Yoshimura et al. discloses composition identical to that presently claimed, it would have been obvious to one of ordinary skill in the art that the film produced by such composition would intrinsically possess gloss identical to that presently claimed.

In light of the motivation for using propylene/1-butene copolymer with specific melt flow rate disclosed by Sadatoshi et al. and the motivation for using low-density polyethylene disclosed by either JP 54120656 or Yoshimura et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such propylene/1-butene and low-density polyethylene in EP 716121 in order to produce composition with good transparency and workability, as well as good moldability, excellent transparency and excellent impact strength, or alternatively, excellent heat, wear, and scratch resistance, or alternatively, excellent stretchability, softness, and strength, and thereby arrive at the claimed invention.

**Response to Arguments**

10. Applicants' arguments filed 8/20/03 have been fully considered but they are not persuasive.

Specifically, applicants argue that:

(a) there is no disclosure in EP 716121 of low density polyethylene or film having gloss as presently claimed.

(b) Sadatoshi et al. utilizes amount of polyethylene outside the scope of the present claims.

(c) Sadatoshi et al. fails to disclose that the resin composition is utilized as laminated film or that the film has gloss as presently claimed.

(d) Comparative data in the present specification establishes unexpected or surprising results over the cited prior art.

With respect to argument (a), it is agreed that there is no disclosure in EP 716121 of low density polyethylene or gloss as presently claimed. This is why EP 716121 is used in combination with JP 54120656 which discloses composition comprising low density polyethylene.

It is noted that EP 716121 discloses composition comprising propylene/1-butene copolymer and polyethylene, however, there is no disclosure that the polyethylene is low density polyethylene.

JP 54120656 discloses composition comprising propylene/1-butene and low density polyethylene and discloses that the motivation for using such low density polyethylene is to produce composition with excellent heat, wear, and scratch resistance as well as good workability time of lamination.

Thus, given that JP 54120656 is drawn to same field of endeavor as EP 716121 and given that JP 54120656 discloses motivation for utilizing low density polyethylene, it is the examiner's position that there is good motivation to combine the references.

Further, given that EP 716121 in combination with Sadatoshi et al. and JP 54120656 discloses composition identical to that presently claimed, it would have been obvious to one of ordinary skill in the art that such composition would intrinsically possess gloss as presently claimed.

With respect to argument (b), while it is agreed that Sadatoshi et al. disclose amount of polyethylene outside the scope of the present claims, Sadatoshi et al. is not used for its teaching of polyethylene but for its teaching of melt flow rate of propylene/1-butene.

Further, note that Sadatoshi et al. is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely the melt flow rate of propylene/1-butene, and in combination with the primary reference, discloses the presently claimed invention.

With respect to argument (c), it is agreed that there is no disclosure of film produced by the composition of Sadatoshi et al. which is why Sadatoshi et al. is not applied against claims 11-15.

However, claim 1 is drawn to composition not film. There is no requirement in claim 1 that a film is actually formed. Claim 1 only requires that a film obtained by extrusion coating the composition would possess gloss of 128-134%. Given that Sadatoshi et al. in combination with EP 716121 and JP 54120656 disclose composition identical to that presently claimed, it is the examiner's position that a film formed from such composition would intrinsically possess gloss as presently claimed.

With respect to argument (d), there is no disclosure in EP 716121 of low density polyethylene which is why EP 716121 is used in combination with JP 54120656 which discloses use of low density polyethylene.

It is noted that applicants set forth comparative examples in Table 1 of the specification. The data compares composition within the scope of the present claims, i.e. comprising propylene/1-butene random copolymer and low density polyethylene as presently claimed, with composition outside the scope of the present claims, i.e. comprising propylene/1-butene random copolymer only. It is shown that the present invention is superior in terms of lamination speed and "neck-in". However, this is the same motivation disclosed in JP 54120656 for using low density polyethylene. Attention is drawn to Table 1 of JP 54120656 wherein comparative example 2, which comprises propylene/1-butene random copolymer only (no low density polyethylene), is shown to be inferior in terms of lamination speed and "neck-in". Thus, the

comparative data of the present specification is not successful in establishing unexpected or surprising results over the cited prior art given that JP 54120656 already disclose the criticality of using low density polyethylene.

Sugano et al. disclose use of propylene/1-butene copolymer, however, there is no disclosure of molecular weight distribution, B value, melting point, and crystallinity of the copolymer. This is why Sugano et al. is used in combination with EP 716121 which teaches the use of propylene/1-butene with these properties.

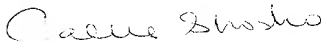
It is noted that comparative examples 2 and 3 show composition outside the scope of the present claims, i.e. containing propylene/1-butene which possess molecular weight distribution and B value outside the scope of the present claims. It is shown that these composition are inferior in terms of gloss. However, it is noted that Table 4-II of EP 716121 compares composition comprising  $M_w/M_n$  and B value as presently claimed (example 10) with composition comprising  $M_w/M_n$  and B value outside the scope of the present claimed (comparative example 4). It is shown that composition with  $M_w/M_n$  and B value as presently claimed are superior in terms of gloss and transparency which is the same motivation for using propylene/1-butene random copolymer with  $M_w/M_n$  and B value as presently claimed as found in the comparative data of the present specification. Thus, it is the examiner's position that the comparative data of the present specification is not successful in establishing unexpected or surprising results over Sugano et al. in view of EP 716121 given that EP 716121 already discloses the criticality of using propylene/1-butene random copolymer with  $M_w/M_n$  and B value as presently claimed.

It is significant to note that with respect to EP 716121, this reference already discloses propylene/1-butene with molecular weight distribution and B value as presently claimed, and thus, as set forth in the response to argument (a), it is clear that the combination of EP 716121 with Sadatoshi et al. and JP 54120656 will intrinsically produce film with gloss as presently claimed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho  
Primary Examiner  
Art Unit 1714